

REMARKS

This Reply is in response to the Office Action mailed on August 19, 2005 in which Claims 1-35 were rejected. Based upon the following remarks, Applicants respectfully request that the rejections of Claims 1-35 be withdrawn.

I. Rejection of Claims 8-13 Under 35 U.S.C. § 101.

Paragraph 2 of the Office Action rejected Claims 8-13 under 35 U.S.C. § 101 “because the language of each claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.” Further with respect to Claims 8-13, paragraph 3 of the Office Action asserted that “the language ‘carrier wave’ is incapable of being touched or perceived absent the tangible medium therefore, it is not limited to tangible embodiments.”

In contrast to the assertions made in paragraphs 2 and 3 of the Office Action, the subject matter of Claims 8-13 does constitute statutory subject matter under 35 U.S.C. § 101. Claims 8-13 recite “a computer instruction signal embodied in a carrier wave carrying instructions that when executed by a processor cause the processor to: receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall; and configure the hard copy output engine using the configuration data.” Thus, Claims 8-13 recite signal claims that transport functional descriptive material that produce a concrete, useful and tangible result when executed by a computer.

In rejecting Claims 8-13, paragraph 2 of the Office Action asserts that the claims are “directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. However, this basis for rejecting Claims 8-13 under 35 U.S.C. § 101 is improper for several reasons. First, the practical application of Claims 8-13

does produce a concrete, useful and tangible result. As recited in Claims 8-13, the result is that a hard copy output engine is configured. The configuring of a hard copy output engine is not an abstract idea. The configuring of a hard copy output engine to run more smoothly or more desirably is clearly a concrete, useful and tangible result.

Second, the application of the “technological art” test is improper. See Gottschalk v. Benson, 409 U.S. 63 (1972). See also Diehr, 450 U.S. at 201 (J. Steven dissenting) (discussing that the Court did not recognize the lower court’s technological art standard). See also Ex Parte Lundgren, Appeal No. 2003-2088, Application 08/093,516 (Precedental BPIA Opinion, September 2005).

In paragraph 3, the Office Action further attempts to assert that a “carrier wave” is not tangible in that it cannot be touched or perceived. However, Applicants respectfully note that claims reciting a signal embodied in carrier wave is tangible since such signals can be captured and analyzed. The mere fact that something cannot be sensed by touch or eye sight does not render something unpatentable. For example, many patented items such as micro devices, nanotechnologies and the like cannot be seen or felt by an unaided human eye or finger.

Moreover, it is well recognized that computer programs embodied in a tangible medium, such as floppy disks are patentable subject matter under 35 U.S.C. § 101. In re Beauregrad, 53 F.3d 1583 (Fed. Cir. 1995) A signal encoded with a functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material in that they both create a functional interrelationship with a computer. A computer may execute an encoded function, regardless of whether the format is a disk or a signal.

Furthermore, the propriety under 35 U.S.C. § 101 of signal claims that transport functional descriptive material that produce a concrete, useful and tangible result when executed by device has been well recognized in prior patents issued by the United States Patent Office. See for example, U.S. Patent No. 6,923,653,

directed to a computer data signal that is embedded in a carrier wave and represents a program for execution by a processor. See also U.S. Patent No. 6,306,033 claiming a computer data signal embodied in a carrier wave for causing a computer to execute a video game. Thus, the rejection of Claims 8-13 under 35 U.S.C. § 101 is improper and should be withdrawn.

II. Rejection of Claims 27-35 Under 35 U.S.C. § 112, First Paragraph.

Paragraphs 5 and 6 of the Office Action rejected Claims 27-35 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, paragraph 6 of the Office Action asserts that:

The language of “a first side of a firewall” and “the second side of a firewall” have never been defined in the specification. In the specification, page 4-9, the firewall only mentioned by the name and security measure ambiguously, and lack of the procedures work with the hard copy output engine, also the interaction between the first side of firewall and the second side of firewall. Therefore, it is impossible to make and/or use the invention to perform the function of the first and second side of the firewall.

In contrast the assertion raised in paragraphs 5 and 6, Claims 27-35 do comply with the enablement requirement under 35 U.S.C. § 112, first paragraph. As acknowledged in the Office Action, the specification does describe a firewall. One of ordinary skill in the art clearly understands what a firewall is in the context of extranet and intranet communications. Likewise, one of ordinary skill in the art would clearly understand what is meant by the recitation that a step is performed on a first side of a firewall based upon input received from a second side of the firewall or that electronic messages are transmitted through a firewall. Originally filed Claim 3 recited the step of receiving an e-mail through a firewall. In order to pass “through” a firewall, the firewall must have a first side and a second side. Accordingly, the rejection of Claims 27-35 under 35 U.S.C. § 112, first paragraph, is improper and should be withdrawn.

III. Rejection of Claims 1-35 Under 35 U.S.C. § 103 Based Upon Moshir and Lomas.

Pages 4-8 of the Office Action rejected Claims 1-35 under 35 U.S.C. § 103(a) as being unpatentable over Moshir et al., U.S. Patent Publication No. 20020100036, in view of Lomas et al., U.S. Patent No. 6,424,424. Applicants respectfully note that the Office Action's reliance on Lomas, U.S. Patent No. 6,424,424, under 35 U.S.C. § 103 to reject Claims 1-35 is improper, rendering the rejection of Claims 1-35 based upon Moshir and Lomas also improper. The present application was filed on October 11, 2001. Lomas was first published on July 23, 2002. Thus, Lomas may only qualify as prior art under 35 U.S.C. § 102(e). However, 35 U.S.C. § 103(c) recites that the subject matter developed by another person which qualifies as prior art only under one or more of subsections (e), (f) and (g) of Section 102 of this title shall not preclude patentability under this section where the subject matter and the claimed subject matter were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Both the present application and Lomas are owned by Hewlett-Packard Company. Accordingly, 35 U.S.C. § 103(c) precludes reliance upon Lomas under 35 U.S.C. § 103. Thus, the rejection of Claims 1-35 under 35 U.S.C. § 103 based upon Moshir and Lomas is improper and should be withdrawn.

IV. Conclusion.

Claims 1-35 are now pending in this application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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